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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,456	08/03/2001	Michael P. Naipawer III	FDN-2605	1371

7590 07/28/2003

GAF MATERIALS CORPORATION

Att: William J. Davis, Esq.
Legal Department, Building No. 10
1361 Alps Road
Wayne, NJ 07470

EXAMINER

BOYD, JENNIFER A

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,456

Applicant(s)

NAIPAWER ET AL.

Examiner

Jennifer A Boyd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed May 8, 2003, have been entered as Paper No. 4 and have been carefully considered. Claims 9 and 13 have been amended and claims 1-15 are pending. The Examiner withdraws the claim objections of claims 9 and 13 as set forth in paragraph 1 of Paper No. 3. Despite this advance, the invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1, 3, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Cooper et al. (GB 2,165,564 A). The rejection is maintained. The details of the rejection can be found in paragraph 2 of Paper No. 3. The Examiner has added more detail to the maintained rejection to clarify the rejection.

Cooper is directed to a method of forming a roof waterproofing system to be applied to a roof deck (page 1, lines 1 – 10 and 50 – 65).

As to claim 1, Cooper teaches a composite comprising a self-adhesive sheet comprising two layers of pressure-sensitive and waterproofing bituminous compound separated by a core layer (page 1, lines 74 – 77). The Examiner equates the two layers of pressure-sensitive and waterproofing bituminous compound to Applicant's "**adhesive layer**" and "**waterproof**,

asphalt-based adhesive layer". Cooper teaches that the bituminous compound is a suitably tacky compound (page 1, lines 77 – 78), which can adhere strongly to materials when moderate pressure is applied (page 1, lines 80 – 85). The core layer is equated to Applicant's **"polyolefin film"**. Cooper teaches that the core layer may be a polymeric film, for example, a polyolefin such as polyethylene, polypropylene or copolymer thereof (page 2, lines 53 – 61). Cooper teaches that the laminate can comprise an integral apertured sheet which is adhered to one face of the bituminous compound (page 1, lines 91 – 95). The Examiner equates the integral apertured sheet to the **"reinforcing mat"** and the face of the bituminous compound to the outside face of the **"waterproof, asphalt-based adhesive layer"**. The apertured sheet is preferably a woven or non-woven sheet of natural or synthetic fiber, preferably a polymer or glass fiber non-woven fabric (page 1, lines 100 – 106). The apertured sheet is substantially impervious to the bituminous compound except where there is an aperture, and the sheet is capable of bonding to a substrate in the area of the aperture (page 1, lines 95 – 100). The adhesive that permeates the apertured sheet through the apertures is equated to the Applicant's second **"waterproof asphalt-based adhesive layer"**. The face of the self-adhesive sheet having the apertured sheet desirably carries a release sheet which may be stripped therefrom to permit the self-adhesive sheet to be applied to the roof deck of the insulation (page 1, lines 125 – 130). Therefore, the release sheet is bonded to the apertured sheet by means of the bituminous compound exposed through the apertures of the apertured sheet. Cooper additionally teaches a release sheet, equated to Applicant's **"polyolefin release film"**, which may be a silicone-treated paper or plastic film, preferably a thin low-melting polymer film such as a polyethylene or polypropylene film (page

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2, lines 1 – 10). A final waterproofing sheet is applied as the top layer of the roof, equated to Applicant's "**surface layer**". The composite can be provided in roll form (page 3, example 3).

Claim Rejections - 35 USC § 103

4. Claims 2, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (GB 2,165,564 A). The rejection is maintained. The details of the rejection can be found in paragraph 4 of Paper No. 3.
5. Claims 4 – 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (GB 2,165,564 A) in view of Stierli (US 4,442,148). The rejection is maintained. The details of the rejection can be found in paragraph 5 of Paper No. 3.
6. Claims 7 – 8 and 13 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. (GB 2,165,564 A) in view of Walther et al. (US 6,319,969). The rejection is maintained. The details of the rejection can be found in paragraph 6 of Paper No. 3.

Response to Arguments

7. Applicant's arguments filed May 8, 2003 have been fully considered but they are not persuasive.
8. As to the Applicant's Argument that Cooper does not disclose each and every layer of the laminate of the Applicant, the Examiner respectfully argues the contrary. The Examiner has reviewed the tables comparing the Applicant's invention and various interpretations of the embodiments of Cooper. The Examiner has interpreted the layers of Cooper in a different fashion compared to the Applicant. Please review the above rejection as being anticipated by

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Cooper, which was further elaborated to clearly show the equated layers and the details of the laminate.

9. In response to the Applicant's Argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the reinforcing mat is solid and continuous without apertures therein) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As currently drafted, claim 1 requires that the "reinforcing mat", or the integral apertured sheet, has a top surface and bottom surface, is adhered to the waterproof, asphalt-adhesive layer. Claim 9 further requires that the "reinforcing mat" is selected from the group of polyester, fiberglass and organic papers having a weight of from about 50 g/m² to about 120g/m². Claim 10 requires that the "reinforcing mat" is polyethylene terephthalate. No claim requires that the "reinforcing mat" is solid and continuous and without apertures.

10. In response to the Applicant's Argument that none of the embodiments of Cooper satisfy the requirements of the Applicant, the Examiner argues the contrary. The embodiments of Cooper are not mutually exclusive. It is reasonable to combine embodiments presented by Cooper to create the laminate of the Applicant.

11. In response to Applicant's Argument that the 35 U.S.C. rejection of claims 2, 9 and 10 as being unpatentable over Cooper are not valid, the Examiner argues the contrary. The Examiner has previously established above that Cooper meets every limitation set forth by the Applicant in the independent claim, therefore, it is reasonable to use such a rejection.

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12. In response to Applicant's Argument that the 35 U.S.C. rejection of claims 4 – 6 as being unpatentable over Cooper in view of Stierli are not valid, the Examiner argues the contrary. The Examiner equates "surface layer" of the Applicant to the thin support sheet of a polyethylene film covering the surface of the bituminous layer of Stierli not the oil impermeable polymeric barrier of Stierli. Stierli's thin support sheet of polyethylene film serves as a strength imparting and supporting member (column 3, lines 52 – 55). It is shown in Figure 1 that the thin support sheet of polyethylene film (3) is used an outer layer to a laminate. The Examiner agrees that Stierli does not teach the complete laminate structure of the Applicant; for this reason, the Examiner has used a 35 U.S.C. rejection to **combine** the laminate of Cooper with the suggestion of Stierli to use a polyethylene film as a protective sheet for a laminate.

13. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning in regards to the 35 U.S.C. rejection as being unpatentable over Cooper et al. in view of Walther, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Cooper does suggest the use of an asphalt-based adhesive and states that the bitumen can contain additional components such as tackifiers, extenders, fillers, pigments and oils (page 1, lines 80 – 85), however, Cooper does not further elaborate on the adhesive. Cooper fails to suggest certain additives and weight percentages of the components of

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the adhesive. It would be reasonable to look to Walther for a specific composition of the asphalt-based adhesive.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

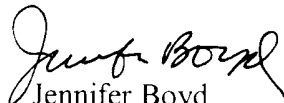
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jennifer Boyd
July 16, 2003

